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FILING DATE FIRST NAMED INVENTOR ATTORNEY DOCKET NO. CONFIRMATION NO. APPLICATION NO. 09:644,556 08/24/2000 Jakob Scharf 2549

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08-14-2002

OBLON SPIVAK MCCLELLAND MAIER & NEUSTADT PC 1755 JEFFERSON DAVIS HIGHWAY ARLINGTON, VA 22202

EXAMINER

TOOMER, CEPHIA D

ART UNIT PAPER NUMBER 1714 6

DATE MAILED: 08/14/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)		
Office Action Summary	Examiner		Group Art Unit	
-The MAILING DATE of this communication appears of	on the cover sheet	beneath the co	orrespondence ac	ddress –
eriod for Reply	2			
SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO F THIS COMMUNICATION.	EXPIRE	MONTH(S	) FROM THE MA	ILING DATE
<ul> <li>Extensions of time may be available under the provisions of 37 CFR 1. from the mailing date of this communication.</li> <li>If the period for reply specified above is less than thirty (30) days, a replied likely likel</li></ul>	oly within the statutory of expire SIX (6) MONTHS tte, cause the application	minimum of thirty (3 from the mailing d on to become ABAN	90) days will be consi ate of this communic NDONED (35 U.S.C. §	dered timely. cation. § 133).
itatus				
☐ Responsive to communication(s) filed on			· · · · · · · · · · · · · · · · · · ·	
☐ This action is <b>FINAL.</b>				
☐ Since this application is in condition for allowance except f accordance with the practice under <i>Ex parte Quayle</i> , 1935			to the merits is o	losed in
Disposition of Claims				
Claim(s)		is/are p	ending in the app	lication.
Of the above claim(s) 5/-6		is/are v	vithdrawn from co	nsideration.
□ Claim(s) 3	2.7 2. 3.7	is/are a	illowed.	
Claim(s) $\frac{3}{1-1}$ Claim(s) $\frac{1-1}{2}$ Claim(s) $\frac{1-1}{2}$ Claim(s) $\frac{3}{1-2}$ Claim(s)	4, 30-38,40,4	$\frac{(9 \times 5)C}{\text{is/are n}}$	ejected.	
$\bigcirc$ Claim(s) $\frac{7}{1}$ $\frac{1}{1}$ $\frac{2}{1}$ $\frac{2}{1}$ $\frac{3}{1}$ $\frac{3}{1}$ $\frac{5}{1}$ $\frac{3}{1}$ $\frac{5}{1}$ $\frac{3}{1}$	41-48	is/are o	bjected to.	
☐ Claim(s)			ject to restriction	or election
pplication Papers		require		
☐ The proposed drawing correction, filed on			ed.	
☐ The drawing(s) filed on is/are objected	ed to by the Examin	er		
☐ The specification is objected to by the Examiner.				
☐ The oath or declaration is objected to by the Examiner.				
Priority under 35 U.S.C. § 119 (a)-(d)				
Acknowledgement is made of a claim for foreign priority ur	nder 35 U.S.C. § 119	(a)-(d).		
★ All □ Some* □ None of the:				
Certified copies of the priority documents have been re-	ceived.			
☐ Certified copies of the priority documents have been re-			<del></del> •	
☐ Copies of the certified copies of the priority documents				
in this national stage application from the International				
*Certified copies not received:				•
attachment(s)	5			
Information Disclosure Statement(s), PTO-1449, Paper No(s)	s)	Interview Sum	mary, PTO-413	
√Notice of Reference(s) Cited, PTO-892		Notice of Infon	mal Patent Applic	ation, PTO-152
☐ Notice of Draftsperson's Patent Drawing Review, PTO-948	С	Other		
Office Ac	tion Summary			

U.S. Patent and Trademark Office PTO-326 (Rev. 11/00)

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#### **DETAILED ACTION**

#### Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- Claims 1-50, drawn to stabilized monomer composition and process for the synthesis of said composition, classified in class 252, subclass 182.29+
- II. Claims 51-61, drawn to process for synthesis of a 2-hydroxyalkyl (meth) acrylate, classified in class 560, subclass 128+.

The inventions are distinct, each from the other because:

Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product of claims 1-50 can be made by another and materially different process, such as by the use of a different ethylenically unsaturated monomer.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with Kirsten A. Grueneberg on June 26, 2002 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-50. Affirmation of this election must be made by applicant in replying to this

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Office action. Claims 51-61 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### Specification

The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

# Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-4, 8-10, 12, 13, 22, 26-33, 36-38, 40 and 49-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Halle (6,020,385).

Halle teaches microencapsulated monomers containing a polymerization inhibitor (see abstract). The monomers comprise, styrene, vinyltoluene, alpha methylstyrene, chlorostyrene, (meth) acrylic acid or esters, (meth) acrylamide, etc. (see col. 1, lines 46-63). The monomers may be admixed with a solvent, such as hexane, methyl ethyl ketone, etc. (see col. 2, lines 62-67). The polymerization inhibitor may include N, N-diethyl hydroxylamine or N- nitrosophenylhydroxylamine or the ammonium or aluminum salt thereof (see col. 3, lines 14-41). The inhibitor is present in the composition in an

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amount from 10 to 1000 ppm (see col. 3, lines 57-65). The composition also contains phosphate buffers (col. 4, lines 29-34). Halle teaches the limitations of the claims other than the difference that is discussed below.

Halle differs from the claims in that he does not specifically teach a monomer composition wherein both inhibitors are present. However, it would have been obvious to one of ordinary skill in the art to have used both inhibitors because it is prima facie obvious to combine two components each which is taught by the prior art to be useful for the same purpose, in order to form a composition to be used for the very same purpose.

Claims 1-6, 8,13, 24-27, 29-34, 36 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 467850.

EP teaches a monomer composition comprising an ethylenically unsaturated monomer and polymerization inhibitors (see abstract). The inhibitors are phenothiazine and N,N- diethylhydroxylamine in a ratio of 1:10 to 1000:1 (see page 5, lines 6-12). The monomers are selected from styrene, alpha-styrene, meth (acrylic) acid and esters, 2-hydroxyethyl (meth) acrylate (see page 5, lines 16-27). EP teaches that the composition may also contain additional inhibitors such as nitrosphenylhydroxylamine (see page 5, lines 47-50). The composition may also contain UV absorbers and stabilizers (see page 5, lines 51-53). EP teaches the limitations of the claims other than the difference that is discussed below.

EP differs from the claims in that he does not specifically teach a monomers composition wherein both of the claimed inhibitors are present. However, it would have

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been obvious to one of ordinary skill in the art to have used both inhibitors because it is prima facie obvious to combine two components, each of which is taught by the prior art to be useful for the same purpose, in order to form a composition to be used for the very same purpose.

Claims 7, 11, 14-21, 23, 27, 35, 39 and 41-48 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art fails to teach or suggest the claimed (meth) acrylic acid amides; maleic acid derivatives; specific inhibitors or antioxidants or the specific solvents.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cephia D. Toomer whose telephone number is 703-308-2509. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9310 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Cephia D. Toomer Primary Examiner Art Unit 1714

09644556\6 August 13, 2002